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09/812,703	03/19/2001	Terrance Moore	24996	9723

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EXAMINER	
FRENEL, VANEL	
ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/812,703	MOORE ET AL.	
	Examiner	Art Unit	
	Vanel Frenel	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *11* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 06/16/03. Claims 1-20 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Javors (US 2002/0152097) in view of McCallum (5,784,635).

(A) As per claim 1, Javors discloses a method of collecting fees for managing and optimizing the profitability of a plurality of physicians in a healthcare practice participating in an insurance network (Abstract, lines 1-16; Page 1, Paragraph 0014-0016), the method comprising the steps of:

funding an incentive pool to be paid to the healthcare practice participating in the insurance network if the ancillary medical costs of the plurality of physicians (Page 6, Paragraph 0084-0085); and distributing predetermined percentages of savings attributed to the physicians' modified ancillary medical cost management behavior (Page 3, Paragraph 0037-0040). Javors does not explicitly disclose establishing a

relationship between a healthcare consultation group and the healthcare practice participating in the insurance network to increase the physician's profitability by reducing a risk of not receiving a predetermined reimbursement amount for ancillary medical costs from the insurance network; and the healthcare practice do not decrease to a preselected level over a preselected period of time.

However, this feature is known in the art, as evidenced by McCallum. In particular, McCallum suggests establishing a relationship between a healthcare consultation group and the healthcare practice participating in the insurance network to increase the physician's profitability by reducing a risk of not receiving a predetermined reimbursement amount for ancillary medical costs from the insurance network; and the healthcare practice do not decrease to a preselected level over a preselected period of time (See McCallum, Col.8, lines 36-67 to Col.9, line 22).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McCallum within the system of Javors with the motivation of providing physician groups with detailed cost information regarding their patients to facilitate cost and care management in individual practices (See McCallum, Col.3, lines 48-62).

(B) As per claim 2, Javors discloses the method wherein the step of distributing the predetermined percentages of the savings includes dividing the savings between the healthcare consultation group, the healthcare practice, and the insurance network (Page 6, Paragraph 0084-0085).

(C) As per claim 3, Javors discloses the method further comprising collecting no fee if the healthcare practice does not reduce the ancillary medical costs to the preselected level over the predetermined period of time (Page 2, Paragraph 0031-0034).

(D) As per claim 4, Javors discloses the method wherein each of the respective predetermined percentages of savings distributed to the healthcare consultation group and the healthcare practice are greater than the predetermined percentage of the savings distributed to the insurance network (Page 3, Paragraph 0050-0055).

(E) As per claim 5, Javors discloses the method further comprises providing a billing structure wherein the savings are calculated by subtracting current ancillary medical costs from predetermined baseline ancillary medical costs (Page 5, Paragraph 0072-0076).

(F) As per claim 6, Javors discloses the method further comprising calculating the fee for the healthcare consultation group by multiplying a predetermined percentage of the savings by the number of patients participating in the healthcare practice (Page 6, Paragraph 0084-0086; Page 7, Paragraph 0098-0101).

(G) As per claim 7, Javors discloses the method wherein the ancillary medical costs include any costs taken from the group of pharmacy, radiology, laboratory,

anesthesiology, occupational therapy, physical therapy, speech therapy, therapeutic radiology, operating room, or emergency room costs (Page10, Paragraph 0174-0186).

(H) As per claim 8, Javors discloses a method of collecting fees for managing and optimizing the profitability of a plurality of physicians in a healthcare practice participating in an insurance network (Abstract, lines 1-16; Page 1, Paragraph 0014-0016), the method comprising the steps of:

distributing predetermined percentages of savings attributed to the physicians' modified ancillary medical cost management behavior (Page 3, Paragraph 0037-0040).

Javors does not explicitly disclose that establishing a relationship between a healthcare consultation group and the healthcare practice participating in the insurance network to increase the physician's profitability by reducing a risk of not receiving a predetermined reimbursement amount for ancillary medical costs from the insurance network (Col.8, lines 36-67 to Col.9, line16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McCallum within the system of Javors with the motivation of providing physician groups with detailed cost information regarding their patients to facilitate cost and care management in individual practices (See McCallum, Col.3, lines 48-62).

(I) As per claim 9, Javors discloses the method further comprises funding an incentive pool to be paid to the healthcare practice participating in the insurance network if the ancillary

medical costs of the plurality of physicians in the healthcare practice do not decrease to a preselected level over a preselected period of time (Page 2, Paragraph 0031-0034).

(J) As per claim 10, Javors discloses the method wherein the step of distributing the predetermined percentages of the savings includes dividing the savings between the healthcare consultation group, the healthcare practice, and the insurance network (Page 6, Paragraph 0084-0085).

(K) As per claim 11, Javors discloses the method further comprising collecting no fee if the healthcare practice does not reduce the ancillary medical costs to the preselected level over the predetermined period of time (Page 2, Paragraph 0031-0034).

(L) As per claim 12, Javors discloses the method wherein each of the respective predetermined percentages of savings distributed to the healthcare consultation group and the healthcare practice are greater than the predetermined percentage of the savings distributed to the insurance network (Page 3, Paragraph 0050-0055).

(M) As per claim 13, Javors discloses a method of collecting fees for managing and optimizing the profitability of an insurance network having a plurality of physicians in a healthcare practice participating therein (Abstract, lines 1-16; Page 1, Paragraph 0014-0016), the method comprising the steps of:

distributing predetermined percentages of savings attributed to the physicians' modified ancillary medical cost management behavior (Page 3, Paragraph 0037-0040).

Javors does not explicitly disclose that establishing a relationship between a healthcare management consultation group and the healthcare practice participating in the insurance network to increase the insurance network's profitability by limiting the plurality of physicians' ancillary medical cost management behavior that is not preferred by the insurance network.

However, this feature is known in the art, as evidenced by McCallum. In particular, McCallum suggests that establishing a relationship between a healthcare management consultation group and the healthcare practice participating in the insurance network to increase the insurance network's profitability by limiting the plurality of physicians' ancillary medical cost management behavior that is not preferred by the insurance network (Col.8, lines 36-67 to Col.9, line16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of McCallum within the system of Javors with the motivation of providing physician groups with detailed cost information regarding their patients to facilitate cost and care management in individual practices (See McCallum, Col.3, lines 48-62).

(N) As per claim 14, McCallum discloses the method further comprising funding an incentive pool to be paid to the insurance network if the modified medical management practices do not decrease ancillary medical costs of the insurance network to a preselected level over a preselected period of time (See McCallum, Col.8, lines 36-67 to Col.9, line 22).

(O) As per claim 15, Javors discloses the method wherein the step of distributing the predetermined percentages of the savings includes dividing the savings between the healthcare management consultation group, the healthcare practice, and the insurance network (Page 6, Paragraph 0084-0085).

(P) As per claim 16, McCallum discloses the method further comprising collecting no fee if the insurance network does not decrease ancillary medical costs to the preselected level over the preselected period of time (See McCallum, Col.8, lines 36-67 to Col.9, line 22).

(Q) As per claim 17, Javors discloses the method wherein each of the respective predetermined percentages of savings distributed to the healthcare consultation group and the insurance network are greater than the predetermined percentage of the savings distributed to the healthcare practice (Page 6, Paragraph 0084-0086; Page 7, Paragraph 0098-0101).

(R) As per claim 18, Javors discloses the method further comprises providing a billing structure wherein the savings are calculated by subtracting current ancillary medical costs from predetermined ancillary medical costs (Page 10, Paragraph 0174-0176).

(S) As per claim 19, Javors discloses the method further comprising calculating the fee for the healthcare consultation group by multiplying a predetermined percentage of the savings by the number of patients participating in the healthcare practice (Page 7, Paragraph 0110-0115).

(T) As per claim 20, Javors discloses the method wherein the ancillary medical costs include any costs taken from the group of pharmacy, radiology, laboratory, anesthesiology, occupational therapy, physical therapy, speech therapy, therapeutic radiology, operating room, or emergency room costs (Page 10, Paragraph 0174-0188).

Response to Arguments

4. Applicant's arguments filed on 06/12/03 with respect to claims 1-20 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 06/12/03.

(A) At pages 7-15 of the 06/12/03 response, Applicant argues:

(1) Javors fails to teach or suggest a method of collecting fees for managing and optimizing the profitability of a plurality of physicians in a healthcare practice participating in an insurance network.

(2) the rejection is improper for at least three reasons. First, each of Javors and McCallum fails to disclose or suggest what the Examiner alleges it discloses. Second, because there is no motivation to combine these patent documents. Applicants believe that the Examiner has used improper hindsight by using Applicant's patent application disclosure as a road map to then piecemeal elements from these Javors and McCallum

patent documents together in an attempt to reject the claims. Third, Applicants also believe that even if these patent documents were somehow combinable, the result of the combination would not be the claimed invention. Nor does Javors teach paying the funds to the healthcare practice if the ancillary medical costs of the physicians in the healthcare practice do not decrease to a preselected level over a preselected period of time.

(3) Javors does not teach establishing a relationship between a healthcare consultation group and the healthcare practice participating in an insurance network to increase the physician's profitability by reducing a risk of not receiving a predetermined reimbursement amount for ancillary costs from the insurance network.

(4) McCallum does not teach even remotely suggest establishing a relationship between a healthcare consultation group and the healthcare practice participating in an insurance network to increase the physician's profitability by reducing a risk of not receiving a predetermined reimbursement amount for ancillary costs from the insurance network. Nor does Javors teach paying the funds to the healthcare practice if the ancillary medical costs of the physicians in the healthcare practice do not decrease to a preselected level over a preselected period of time.

(5) Javors does not teach distributing predetermined percentage of savings by dividing the savings among the healthcare consultation group, the healthcare practice and the insurance network. In fact, Javors does not even suggest establishing a relationship between the healthcare consultation group and the healthcare practice.

(6) Javors does not teach anything about distributing differentiated predetermined percentages of savings to the healthcare consultation group, healthcare practice and insurance network.

(7) Javors does not teach providing a billing structure wherein the savings are calculated by subtracting current ancillary medical costs from predetermined baseline ancillary medical costs.

(8) Javors does not teach calculating a fee for a healthcare consultation group.

However, the Examiner disagrees.

(B) With respect to Applicant's first argument, Examiner respectfully submits that Javors suggests "In today's model of health care delivery, the insurance company and managed care organization (MCO), play a strong, controlling role. Managed Care Organization, or MCO, is the generic term for managed care companies including health maintenance organizations (HMOs), preferred provider organizations (PPOs), and independent provider organizations (IPOs). These organizations dictate what services will be covered and at what cost. Historically, patients with full coverage insurance were often encouraged by providers to over-utilize healthcare services because there were no direct costs to the patient for the services, and providers often had a financial incentive to promote over-utilization of these services" which correspond to Applicant's claimed feature (See Javors, Col.1, Paragraph 0014), because the above passage establishes that medical service providers are motivated to optimize profitability by the

incentives due to promotion of HMO, PPO, MCO or IPO services. Therefore, Applicant argument is not persuasive.

With respect to Applicant's second argument, Examiner respectfully submits that obviousness is not determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See In *re Oetiker*, 977F. 2d 1443, 1445,24 USPQ2d 1443, 1444 (Fed. Cir. 1992); In *re Hedges*, 783F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir.1992); In *re Piaseckii*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir.1984); In *re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a prima facie case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (See paper number 10). Note, for example, in the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specially support that particular motivation and /or an explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness. As such, it is not seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one of ordinarily skilled in the art at the time of the invention that support

a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300(Bd. Pat. App.& Inter., 4/22/93). Therefore, the combination of references is proper and the rejection is maintained.

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, In *re Bozek*, 163 USPQ 545 (CCPA 1969). Therefore, Applicant's argument is not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Also, with respect to "paying the funds do not decrease", Examiner respectfully notes that Javors discloses "as employees and their dependants incur "health care" expenses, payments will be made through a succession of deductibles; a personal Health Care Account, funded through part of the employer's premium, for the bulk of normal expenditures; and an Umbrella Account for catastrophic or chronic coverage.

Employees and their dependants are aggressively encouraged to be "smart health care customers" by providing them an opportunity to reap the benefits of utilizing the resources offered to them in the selection of their medical care. At the end of the benefit year, any funds left in the Health Care Accounts are paid directly to the employee. Additionally, if any employee follows the protocols of the plan which are focused on health management, he or she will be rewarded for their participation through a portion of the unspent funds in the Umbrella Account. Thus, every dollar in a funded Health Care Account not spent by a benefit plan beneficiary can be returned to the benefit plan enrollee at the end of the benefit plan year.

Alternatively, funds remaining in the fuded Health Care Account or funded Umbrella Account can be rolled over into the next benefit plan year'sHealth Care Account and Umbrella Account, or individual or family deductible requirement to further decrease the premium amount required to fund those accounts in the following benefit plan year" which correspond to Applicant claimed feature (See Javors, Paragraphs 0085-0087). Therefore, Applicant's argument is not persuasive.

(C) With respect to Applicant's third argument, Examiner respectfully submits that Javors suggests "the services of the Health Care Teams and a sophisticated information system in a method to enhance quality, service, and productivity for enrollees while decreasing costs. The use of this method enables enhancement of the quality of care in large populations. This focus of " Health Management" represents a shift in the focal point of medical care delivery. Instead of focusing on the management of many individual patient visits, the providers in population management seek to reduce risks and improve the overall health of defined populations by understanding and coordinating the series of health care needs of individual patients including education, prevention, physician visits, hospital visits, and follow-up efforts" which correspond to Applicant's claimed feature (See Javors, Col.8, Paragraph 0141). Therefore, Applicant's argument is not persuasive.

(D) With respect to Applicant fourth argument, Examiner respectfully submits that Javors suggests "the opportunity created by the failure of MCOs by reducing the short and long-term premium costs to employers, improving the health and quality of care of employees and their dependents; and increasing the satisfaction of medical providers and patients" which correspond to Applicant claimed feature (See Javors, Col.3, Paragraph 0050). Therefore, Applicant's argument is not persuasive.

(E) With respect to Applicant's fifth argument, Examiner respectfully submits that Javors suggests "reserve function of any self-funded entity, whether a MEWA or a

larger self-insured employer, to lower costs in the long run. At the start of the benefit year, the amount necessary to fund the plan will be determined. After the amounts for the Health Care Accounts and the administrative costs are subtracted, the remainder will be placed into the Umbrella/reserve.

This money will be used to fund the medical claims after the Health Care Accounts are depleted. At the end of the benefit year, money left over is divided; for example, 40% to the employer, 40% to be divided equally among the employees, 10% to fund additional prevention programs, for the covered beneficiaries, and 10% for administrative costs" which correspond to Applicant claimed feature (See Javors, Col.10, Paragraphs 0174-0175). Therefore, Applicant's argument is not persuasive.

(F) With respect to Applicant's sixth and seventh arguments, Examiner respectfully submits that Javors suggests "reserve function of any self-funded entity, whether a MEWA or a larger self-insured employer, to lower costs in the long run. At the start of the benefit year, the amount necessary to fund the plan will be determined. After the amounts for the Health Care Accounts and the administrative costs are subtracted, the remainder will be placed into the Umbrella/reserve.

This money will be used to fund the medical claims after the Health Care Accounts are depleted. At the end of the benefit year, money left over is divided; for example, 40% to the employer, 40% to be divided equally among the employees, 10% to fund additional prevention programs, for the covered beneficiaries, and 10% for

administrative costs" which correspond to Applicant claimed feature (See Javors, Col.10, Paragraphs 0174-0175). Therefore, Applicant's arguments are not persuasive.

(G) With respect to Applicant's eighth argument, Examiner respectfully submits that Javors suggests "funds are disbursed to the benefit plan beneficiary as a reimbursement for monies paid to health care service providers directly from the benefit plan beneficiary" which correspond to Applicant claimed feature (See Javors, Col.3, Paragraph 0039). Therefore, Applicant's argument is not persuasive.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied teaches system and method for supporting delivery of health care (6,012,035),system for monitoring and managing the health care of a patient population (6,385,589), system for and method of collecting and populating a database with physician/patient data for processing to improve practice quality and healthcare delivery (6,151, 581) and system and method for replacing a liability with insurance and for analyzing data and generating documents pertaining to a premium financing mechanism paying for such insurance (6,026, 364).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F
September 6, 2003

JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600